

ESTTA Tracking number: **ESTTA530470**Filing date: **04/04/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	Galperti, Inc.		
Entity	Corporation	Citizenship	Texas
Address	160 Southbelt Industrial Drive Houston, TX 77047 UNITED STATES		

Attorney information	Wade A. Johnson Thompson & Knight LLP 333 Clay Street, Suite 3300 Houston, TX 77002 UNITED STATES wade.johnson@tklaw.com, jennifer.sickler@tklaw.com Phone:713-653-8652
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**Registration Subject to Cancellation**

Registration No	3411812	Registration date	04/15/2008
International Registration No.	NONE	International Registration Date	NONE
Registrant	GALPERTI S.r.l. Via Provinciale, 20/22 Cortenova (Lecco), I23813 ITALY		

**Goods/Services Subject to Cancellation**

Class 006. All goods and services in the class are cancelled, namely: Ironmongery in the form of metal hardware, namely, flanges, ring-shaped fittings of metal, and forgings
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**Grounds for Cancellation**

False suggestion of a connection	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Mark Cited by Petitioner as Basis for Cancellation**

U.S. Application No.	85891629	Application Date	04/01/2013
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	G GALPERTI INC. THE ORIGINAL
Design Mark	
Description of Mark	The mark consists of The mark consists of a G inside a stylized flange symbol inside a box shape above the words GALPERTI INC. in stylized font, which are positioned above the words THE ORIGINAL.
Goods/Services	Class 040. First use: First Use: 2006/11/00 First Use In Commerce: 2006/11/00 Forging of metal goods to the specification of others; manufacture and machining of industrial products, namely, flanges, swivel ring assemblies, buckle arrestors, and rolled rings

Attachments	GalpertiPetitionforCancellation.pdf ( 4 pages )(123999 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Wade A. Johnson/
Name	Wade A. Johnson
Date	04/04/2013

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

GALPERTI, INC.,	§	
	§	
Petitioner,	§	Cancellation No. _____
	§	
vs.	§	
	§	In the matter of:
	§	U.S. Reg. No. 3,411,812 for GALPERTI
GALPERTI S.R.L.,	§	
	§	
Registrant.	§	

**PETITION FOR CANCELLATION**

Petitioner, Galperti, Inc., a Texas Corporation, having a business address of 160 Southbelt Industrial Drive, Houston, Texas 77047, (“Petitioner”), believes that it is and will be damaged by U.S. Trademark Registration No. 3,411,812, and hereby petitions to cancel this registration.

The grounds for cancellation are as follows:

1. On information and belief, the name and address of the owner of Registration No. 3,411,812 is Galperti S.R.L. (“Registrant”), an Italian Limited Liability Company, having a business address of Via Provinciale 20/22, 23813 Cortenova (LC), Italy.
  
2. Since at least as early as 1978, Petitioner has used, and continues to use, the GALPERTI marks in connection with the manufacture, marketing, and sale of flanges, swivel ring assemblies, buckle arrestors, rolled rings, and other forged products.
  
3. Petitioner owns U.S. Trademark Application Serial No. 85/891,629 for the GALPERTI design mark. That application, as well as Applicant’s common law trademark rights, which extend to other goods and services, are referred to herein as the “GALPERTI Marks”.

4. According to the U.S. Patent and Trademark Office records, Registrant filed an application for “GALPERTI” on November 23, 2006, for “ironmongery in the form of metal hardware, namely, flanges, ring-shaped fittings of metal, and forgings.” Its application registered on April 15, 2008 as U.S. Trademark Registration No. 3,411,812 (“Registrant’s Registration”). Registrant asserted that it had used the mark in interstate commerce within the United States since 1965. However, publicly available records show that Registrant did not use the GALPERTI mark in the United States until 1986 or later. Thus, Petitioner has priority of use in the GALPERTI Marks and variations thereof. Registrant is not, and was not at the time of filing of its application for registration, the rightful owner of the GALPERTI mark. Accordingly, Petitioner is entitled to cancellation of Registrant’s Registration No. 3,411,812 for GALPERTI.

5. Registrant’s Registration of the GALPERTI mark constitutes a fraudulent registration, on information and belief, in violation of 35 U.S.C. §1120, because Registrant made a false representation to the U.S. Patent and Trademark Office regarding when it first used the mark in interstate commerce within the United States. Registrant also falsely represented that it was the owner of the GALPERTI mark with full knowledge that Petitioner was already using the GALPERTI mark in the United States for the same goods and services. Accordingly, U.S. Registration No. 3,411,812 should be cancelled for violation of 35 U.S.C. §1120.

6. Registrant’s goods and services sold under the GALPERTI mark are identical to or related to Petitioner’s. Registrant’s Registration has and is likely to cause confusion, mistake, and deception about the origin of Registrant’s goods and services, and will dilute the distinctiveness of Petitioner’s GALPERTI Marks. Registrant’s use of the GALPERTI mark has resulted in actual confusion in the marketplace in that customers have mistakenly believed that

Registrant's goods were those of Petitioner. Registrant's conduct is calculated to and will cause irreparable loss, injury, and damages to Petitioner's business and its good will in the GALPERTI Marks.

7. Unless Registration No. 3,411,812 is cancelled, Petitioner will be denied the benefits of its application and its trademark rights.

WHEREFORE, Petitioner respectfully requests that this cancellation petition be granted and that Registration No. 3,411,812 be cancelled. The Commissioner is authorized to charge Petitioner's Deposit Account 20-0821 for the \$300.00 petition fee, and any additional fees required by this filing.

Dated: April 4, 2013

Respectfully submitted,

/s/ Wade A. Johnson

Wade A. Johnson

Reg. No. 62,525

Jennifer S. Sickler

Reg. No. 36,500

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ATTORNEYS FOR PETITIONER  
GALPERTI, INC.

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing Petition for Cancellation was served by first class mail, postage pre-paid on this 4th day of April, 2013, upon Registrant's attorney of record, at the correspondence address of record:

Jeffrey H. Kaufman  
Oblon Spivak McClelland Maier & Neustadt, L.L.P.  
1940 Duke Street  
Alexandria, Virginia 22314

/s/ Wade A. Johnson  
Wade A. Jonson